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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,809	12/26/2001	Tomo Watanabe	041465-5131	5982
55694 7590 07/05/2007 DRINKER BIDDLE & REATH (DC) 1500 K STREET, N.W. SUITE 1100 WASHINGTON, DC 20005-1209			EXAMINER PYZOCHA, MICHAEL J	
			ART UNIT 2137	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/025,809

Applicant(s)

WATANABE ET AL.

Examiner

Michael Pyzocha

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Claims 1-25 are pending.
2. Amendment filed 05/30/2007 have been received and considered.

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liebenow (US 6012146) in view of McLean et al. (US 5282247).

As per claims 1 and 25, Liebenow discloses a password that is common for a plurality of data processing apparatuses that is recorded on a recording medium before installation of the data into the data processing unit (see column 2 line 49 through column 3 line 25).

Liebenow fails to disclose a password that is unique for each individual data processing apparatus and replacing the password on the recording medium with the unique password after installation.

However, McLean et al. teaches a password that is unique for each individual data processing apparatus and setting the

Art Unit: 2137

password on the recording medium with the unique password after installation (see column 8 lines 33-48).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to replace the common key of Liebenow with a device specific key after installation.

Motivation to do so would have been to provide a system where the memory could be unlocked only when inserted in that particular host computer system (see McLean et al. column 8 lines 33-48).

The modified Liebenow and McLean et al. system further disclose the passwords prevent data from being illegally copied and distributed from the recording medium and the data processing apparatus (see Liebenow column 1 lines 55-67 and McLean column 3 lines 15-29).

5. Claims 4, 5, 7-16, and 19-22 rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Liebenow and McLean et al. system as applied to claims 1 and 25 above, and further in view of Grimes et al. (US 6964045).

As per claims 4, 8, 9 and 11, the modified Liebenow and McLean et al. system discloses a password memory device which stores a first password that is unique for each data processing apparatus, and that must be used in order to perform recording

Art Unit: 2137

of data on or reproduction of data from said recording medium; a recording and reproduction device which uses said stored first password to perform recording or reproduction; a judgment device which determines whether or not it is possible to perform recording of data to or reproduction of data from a recording medium by using a second password that must be used in order to perform recording of data on or reproduction of data from said recording medium (see Liebenow column 2 line 49 through column 3 line 25 and McLean et al. column 8 lines 33-48).

The modified Liebenow and McLean et al. system fails to disclose the use of the recording medium for updating the system.

However, Grimes et al. teaches the use of recording media for updates (see column 2 line 58 through column 3 line 5).

At the time of the invention it would have been obvious to a person of ordinary skill in the art for the recording media of Liebenow and McLean et al. to contain updates for the system.

Motivation to do so would have been to provide quick updating of the system (see Grimes et al. column 2 line 58 through column 3 line 5).

As per claims 5, 7, 10 and 12, the modified Liebenow, McLean et al. and Grimes et al. system discloses the second password is common for a plurality of update recording media

Art Unit: 2137

determined to be proper and stored together with the update recording medium (see Liebenow column 2 line 49 through column 3 line 25).

As per claims 13-16, and 19-22, the modified Liebenow, McLean et al. and Grimes et al. system discloses the re-writable recording medium comprises first data; second data which is used for updating the first data; a first password which is used for access to the first data and is unique for each apparatus and stored in a first medium; and a second password which is used for access to the second data and stored in a second medium; and the controlling device clears restriction of access to the first data with use of the first password; the controlling device determines whether or not the second data is original with use of the second password; and the controlling device changes the first data to the second data when the second data is determined to be original the changing of the second password occurs after the updating (see Liebenow column 2 line 49 through column 3 line 25 and McLean et al. column 8 lines 33-48).

6. Claims 2, 3, 6, 17, and 23 rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Liebenow, McLean et al. and Grimes et al. system as applied above, and further in view of Morisawa et al. (US 5537544).

Art Unit: 2137

As per claims 2 and 3, the modified Liebenow, McLean et al. and Grimes et al. system discloses an extraction device which extracts the password that are recorded on said recording medium; a judgment device which determines the contents of said extracted password data; an update device which updates said password that are recorded on said recording medium to said first password data when said judged contents are the same as the contents of said second password; a recording and reproduction device which performs at least recording data on or reproducing data from said recording medium; and a prohibiting device which prohibits execution of said recording or said reproduction when said judged contents differ from both the contents of said first password and contents of said second password that are stored in said memory device (see Liebenow column 2 line 49 through column 3 line 25 and McLean et al. column 8 lines 33-48).

The modified Liebenow, McLean et al. and Grimes et al. system fails to disclose the passwords being stored together.

However, Morisawa teaches such a memory (see column 3 lines 14-16, column 5 lines 57-59 and column 34 lines 20-21).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to store both passwords of

Art Unit: 2137

the modified Liebenow, McLean et al. and Grimes et al. system in the same memory.

Motivation to do so would have been to have a password control system that holds one or more registered password to allow data processing when a password identical to one of the registered passwords is inputted (see Morisawa Abstract).

As per claims 6, 17, and 23, the modified Liebenow, McLean et al., Grimes et al., and Morisawa system discloses both passwords being stored together (see Morisawa column 3 lines 14-16, column 5 lines 57-59 and column 34 lines 20-21).

7. Claims 18 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Liebenow, McLean et al. and Grimes et al. system as applied to claims 13 and 19 above, and further in view of Kato (US 6453233).

As per claims 18 and 24, the modified Liebenow, McLean et al. and Grimes et al. system fails to disclose the update program is map data.

However, Kato teaches updating of map data (see column 3 lines 25-64).

At the time of the invention it would have been obvious to a person of ordinary skill in the art for the installation of



Art Unit: 2137

the program of the modified Liebenow, McLean et al. and Grimes et al. system to be map updates.

Motivation to do so would have been to apply differential map updates (see Kato column 4 lines 27-29).

### ***Response to Arguments***

8. Applicant's arguments filed 05/30/2007 have been fully considered but they are not persuasive. Applicant argues that McLean does not disclose the change of passwords is carried out at the same time as the data installation; McLean teaches away from the embodiments because it allows a user to choose the password; the password of Liebenow is merely transferred and not associated with multiple information processing devices; and neither reference teaches the passwords prevent data from being illegally copied and distributed.

With respect to Applicant's argument that McLean does not disclose the change of passwords is carried out at the same time as the data installation this limitation is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant's also state that the passwords are written over between "before" and "on and after";

Art Unit: 2137

this between time is also not claimed. The claimed invention states the changing of passwords after the data installation. This limitation is taught by McLean column 5 lines 19-30 and column 8 lines 33-48 where as user, after installing the memory card, can set the card into a secure mode requires the password to be a device specific serial number.

With respect to Applicant's argument that McLean teaches away from the embodiments because it allows a user to choose the password; this is merely one embodiment allowed by McLean, another one is that when the memory card is set to secure mode the computer system sets the password as its machine readable serial number (see column 8 lines 33-48). Once in this secure mode the data cannot be accessed without the password. Furthermore, without the password it cannot be accessed and therefore cannot be changed and the specification of McLean never teaches the changing or updating of the password, it merely teaches adding new passwords to the memory (see column 6 lines 48-58).

With respect to Applicant's argument that the password of Liebenow is merely transferred and not associated with multiple information processing devices, the portion of Liebenow relied upon for teaching a password that is common for a plurality of information processing devices (the "second" password of the

Art Unit: 2137

claimed invention) is the first password. This password is user dependent and therefore is common for any device the external hard drive is inserted.

With respect to Applicant's argument that neither reference teaches the passwords prevent data from being illegally copied and distributed a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Furthermore, both references teach the password protecting the data stored thereon, which would prevent the illegal copying and distribution of said data (see Liebenow column 1 lines 55-67 and McLean column 3 lines 15-29).

### **Conclusion**

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened

Art Unit: 2137

statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (571) 272-3875. The examiner can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2137

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJP

  
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